

LYONS ET AL. - 10/007,692
Client/Matter: 020826-0280456

REMARKS

Reconsideration and allowance are respectfully requested in view of the following remarks. Additionally, entrance of new claims 23 and 24 is respectfully requested. No claims are amended. The presently pending claims are 1-4, 6-14, and 18-24.

Final Rejection Is Improper and Premature. And Should Be Withdrawn

The outstanding Final Rejection is improper since it contains a new rejection to claim 13, even though claim 13 was not amended.

In the June 26, 2003 Office Action, in paragraph 7, claim 13 was rejected under 35 U.S.C. § 103 as being unpatentable over Kirsten in view of Mori. Claim 13 was further rejected, in paragraph 11, under 35 U.S.C. § 103 as being unpatentable over the combination of Kirsten and Chazen as applied to claims 1-4, 8-12 and 18-20 and further in view of Mori.

In response to the June 26, 2003 Office Action, an Amendment was filed on September 26, 2003, wherein claim 13 was rewritten into independent form. Claim 13 was not amended or changed in any manner.

In the December 23, 2003 Final Office Action, in paragraph 5, claim 13 is rejected under 35 U.S.C. § 103 as being unpatentable over Kirsten *and Wallis* in view of Mori. Claim 13 is further rejected, in paragraph 8, under 35 U.S.C. § 103 as being unpatentable over the combination of Kirsten, *Wallis*, and Chazen as applied to claims 1-4, 8-12 and 18-20 and further in view of Mori. Both rejections to claim 13 in the Final Office Action add the reliance upon Wallis. Thus, both rejections to claim 13 are new grounds of rejection.

Also, the Wallis reference was cited in the June 26, 2003 Office Action.

Since the Final Office Action introduces new grounds of rejection that were neither necessitated by applicants' amendment of the claims nor based on information submitted in an information disclosure statement filed after the non-final Office Action, the Final Rejection is premature and improper, and should be withdrawn. MPEP 706.07(a). Accordingly, withdrawal of the Final Rejection is respectfully requested.

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Prior Art Rejections

Claims 1 and 18

In paragraph 4 of the Office Action, claims 1-4, 6-12 and 18-21 are rejected under 35 U.S.C. §103(a) over the combination of Kirsten in view of Wallis. The rejection is respectfully traversed and reconsideration is respectfully requested.

Claims 1 and 18 recite that the first force applying mechanism includes "a force applying element connected between a first force applying device and said adjustable post, with said force applying device constructed and arranged to move said force applying element against said adjustable post, which moves said adjustable post along said base and between said first and second cutting positions."

The Office Action states that the screw 15 and the nut 22 of Kirsten are a first force applying mechanism with the screw 15 being a force applying element and the nut 22 being the force applying device. However, in Kirsten, the nuts 22 do *not* move the screws 15, and the nuts 22 are not constructed and arranged to move the screws 15. Thus, nuts 22 can not be construed as being the claimed "force applying device."

The Office Action also states that it would have been obvious to provide a pressure cylinder to Kirsten as taught by Wallis "in order to automate the force applying mechanism in Kirsten." As stated above, the nuts 22 can not be a "force applying device." It appears that the screws 15 have a "wrench-receiving portion 21" so that the screw 15 can be turned by a wrench. Thus, if it is assumed that the turning of the screw 15 can move the knife 12, any automation of Kirsten would only involve the automation of the turning of the screw 15. And such an automation would not involve a pressure cylinder as in Wallis, but some sort of apparatus to generate the turning of the screw. Also, there is simply no disclosure or suggestion in the prior art to wholly replace the screw and bolt mechanism of Kirsten, which has very specific functions and interrelations with other parts of the Kirsten device, with a pressure cylinder.

Thus, Kirsten does not disclose a force applying device as claimed. Also, there is no motivation to provide a pressure cylinder to Kirsten. Further, even if one was to provide a pressure cylinder to Kirsten, the pressure cylinder would not be a force applying device to move the force applying element, as claimed.

As to the statement in the Office Action that Fig. 2 of Wallis shows the piston in an upper, locked position, this is mere conjecture and not supported by the disclosure of Wallis. Regardless, assuming arguendo that Fig. 2 does show a locked position, claims 1 and 18

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recite that the cylinder is structured to lock the adjustable post "during cutting," which is not disclosed or suggested in the prior art, and is especially not illustrated in Fig. 2, which does not show any cutting.

Accordingly, withdrawal of the rejection is respectfully requested.

Claim 7

The above arguments directed to claims 1 and 18 are equally applicable to claim 7.

Additionally, claim 7 recites "a second pressure cylinder positioned adjacent to said second side of said adjustable post to apply pressure on said second side of said adjustable post."

The Office Action considers the application of a second pressure cylinder at a second side of the knife 12 of Kirsten to be merely a duplication of parts. However, there must exist a first part for a duplication to exist. Since, as stated above, there is no motivation to provide a first cylinder to Kirsten, there is no motivation to apply a second cylinder.

Even assuming *arguendo* that a first pressure cylinder can be applied to a first side of the knife 12 of Kirsten, a duplication of the first pressure cylinder would be the application of a second pressure cylinder *on the same side* as the first pressure cylinder. The application of a second pressure cylinder on the opposite side of the first cylinder that performs a different function than the first cylinder can not be considered a duplication of the first cylinder.

Additionally, since Kirsten does not have an apparatus on the left side of the knife 12 (as seen in Fig. 3), it would be improper to merely duplicate a device from the right side and install it on the left side. For example, installing the screws 15 on the left side as well as the right side of knife 12 would be improper since the screws on the left side would perform a different function than those on the right. Also, having screws on the left would interfere with the use of the knife.

Further, the Office Action's contention that providing a second pressure cylinder is obvious to move the knife if a pressure cylinder was to fail is conjecture and not supported by any objective evidence, including not being supported by any disclosure in any of the patents relied upon. Therefore, the reliance on this conjecture is improper.

Accordingly, withdrawal of the rejection is respectfully requested.

Claim 13

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In paragraph 5 of the Office Action, claims 13 and 22 are rejected under 35 U.S.C. §103(a) over the combination of Kirsten in view of Wallis and further in view of Mori. This rejection is respectfully traversed.

As stated above, since Kirsten fails to disclose a force applying mechanism as claimed, the rejection is improper.

Additionally, the reliance upon Mori for providing a second stop is improper. Mori discloses stops 15 for a *moving* cutting blade 20. At best, the stops of Mori would be provided only to the *vertical* knife 12' of Kirsten since the vertical knife 12' is the *moving* cutting blade. Mori provides no disclosure or suggestion to provide a stop for an adjustable, *stationary* knife to restrict movement of the stationary knife during adjustment of its position relative to the moving cutting knife 12'.

Further, the Office Action states on pages 8 and 9 that providing the stops to the knife 12 of Kirsten are obvious since "...stops prevent damage to the adjustable post by restricting movement of the adjustable post into the path of the impacting post." This rationale is precisely set forth in Applicants' own disclosure (Applicants' Specification page 5). The use of the Applicants' own disclosure is improper and is evidence that the Office Action is conducting impermissible, hindsight reconstruction.

Accordingly, withdrawal of the rejection is respectfully requested.

Claim 14

In paragraph 6 of the Office Action, claim 14 is rejected under 35 U.S.C. §103(a) over the combination of Kirsten, Wallis, and Mori as in claim 13 and further in view of Graham. This rejection is respectfully traversed.

The Office Action relies on Graham to disclose a gib. This does not make up for the deficiencies noted above with respect to Kirsten. Accordingly, withdrawal of the rejection is respectfully requested.

Other Prior Art Rejections

In paragraph 7 of the Office Action, claims 1-4, 8-12, and 18-21 are rejected under 35 U.S.C. §103(a) over Kirsten in view of Wallis and Chazen. This rejection is respectfully traversed.

The Office Action relies on Chazen to disclose an alligator shear that teaches an impact position and an elevated position. This does not make up for the deficiencies noted

above with respect to Kirsten. Accordingly, withdrawal of the rejection is respectfully requested.

In paragraph 8 of the Office Action, claim 13 is rejected under 35 U.S.C. §103(a) over the combination of Kirsten, Wallis, and Chazen, and further in view of Mori. This rejection is respectfully traversed.

The Office Action relies on Chazen to disclose an alligator shear that teaches an impact position and an elevated position. This does not make up for the deficiencies noted above with respect to Kirsten and Mori. Accordingly, withdrawal of the rejection is respectfully requested.

In paragraph 9 of the Office Action, claim 14 is rejected under 35 U.S.C. §103(a) over the combination of Kirsten, Wallis, and Chazen, and further in view of Graham. This rejection is respectfully traversed.

The Office Action relies on Chazen to disclose an alligator shear that teaches an impact position and an elevated position. This does not make up for the deficiencies noted above with respect to Kirsten and Graham. Accordingly, withdrawal of the rejection is respectfully requested.

New Claims

New claims 23 and 24 have been added to recite additional aspects of an embodiment of the invention.

All objections and rejections have been addressed. It is respectfully submitted that the present application is now in condition for allowance, and a notice to that effect is earnestly solicited.

Please charge any fees associated with the submission of this paper to Deposit Account Number 033975. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

Should there be any questions or concerns regarding this Application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,

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I hereby certify that this paper is being facsimile transmitted to the Patent and Trademark Office on the date shown below.

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